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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PALM-3741.SG

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12/12/06

on \_\_\_\_\_

Signature

Typed or printed name Julie Williams

Application Number

10/083,312

Filed

2/25/02

First Named Inventor

Kammer, et al.

Art Unit

2618

Examiner

Tuan, A. Tran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 35,295

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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12/12/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of 4 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Palm-3741.SG

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kammer et al.

Serial: 10/083,312

Group Art Unit: 2618

Filed: February 25, 2002

Examiner: Tuan A. Tran

For: BYPASSING BLUETOOTH DISCOVERY FOR DEVICES IN A  
SPECIAL LIST

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action dated June 12, 2006 Applicants respectfully request review of the final rejection in the above-identified application. Applicants respectfully submit that the Examiner's rejections of the Claims are improper as an essential element needed for a proper prima facie rejection is missing (e.g., the teaching of all of the recited claim limitations). Claims 1-24 stand rejected under 35 U.S.C. § 102(e) as being allegedly unpatentable over Phillipps (WO 02/09362, "Phillipps").

## KEY CLAIM LIMITATIONS THAT ARE NOT MET BY THE CITED REFERENCES

With respect to independent Claims 1, 13 and 19, Phillipps does not teach or fairly suggest the limitation of “wherein said establishing bypasses a Bluetooth discovery process” as recited by independent Claims 1, 13 and 19. Phillipps is replete with examples and references that teach conventional use of Bluetooth discovery, including, “[t]he transceiver is adapted for ... transmission and reception according to the Bluetooth specification” (page 3 lines 18-19), and “Bluetooth devices perform a discovery operation to locate other Bluetooth devices...” (page 3 lines 27-28, emphasis added). By teaching performing a discovery operation, Phillipps actually teaches away from the recited bypassing a discovery process. The Examiner appears to interpret an embodiment of Phillipps that does not specifically recite performing discovery as a teaching not to perform discovery, as recited. The lack of a specific teaching of an operation is not a teaching to not perform that operation. Further, Phillipps teaches performing that operation (Bluetooth discovery) elsewhere. The recited limitation is not found in Phillipps.

In the rejection, the Examiner states, “it is necessary to start the inquiry (discovery) process.” Herein, the Examiner concedes and confirms that Phillipps teaches use of discovery, in contrast to the recited limitation of bypassing discovery.

With respect to Claim 3, Phillipps fails to teach or fairly suggest the limitation, “said device identification is entered by a user of said second hand held computer system” as recited by Claim 3. The rejection argues that Phillipps teaches “selection” from a previously populated list, and alleges that the taught “selection” suggests the recited “entry.” “Entry” is not suggested by “selection.” For example, “selection” requires storage in a device prior to use, e.g., resulting from the taught discovery process.

For example, an address printed on a device can be read and “entered” as recited by a user. The same address, if not pre-populated in a list, cannot be “selected” as taught. Thus, the recited “entry,” having utility beyond that of the taught “selection,” is differentiated.

With respect to Claim 6, Applicants respectfully assert that Phillipps fails to teach or fairly suggest the limitation, “responsive to a failure of said (establishing a Bluetooth connection between said second hand held computer system and said first handheld computer system, wherein said establishing bypasses a Bluetooth discovery process) beginning said Bluetooth discovery process” as recited by Claim 6. Phillipps in its entirety is silent as to any response to a failure to establish a Bluetooth connection, much less to teach or fairly suggest beginning said Bluetooth discovery process responsive to such a failure, as recited by Claim 6. The rejection cites two methods for establishing pico nets. Neither method contemplates a communication failure. The recited limitation is not found in Phillipps.

With respect to independent Claim 7, Applicants respectfully assert that Phillipps fails to teach or fairly suggest the limitation, “rejecting a Bluetooth communications request” as recited by independent Claim 7. Phillipps in its entirety is silent as to this limitation. The rejection cites a method of establishing a communication. The taught method is silent as to rejecting a communication request, as recited by Claim 7. The recited limitation is not found in Phillipps.

In addition with respect to Claim 7, Applicants respectfully assert that Phillipps fails to teach or fairly suggest the limitation, “receiving a Bluetooth communications request” in conjunction with “rejecting a Bluetooth communications request” as recited by independent Claim 7. The cited portion of Phillipps teaches a process that excludes

radio, e.g., Bluetooth, communication, whereas the recited limitation requires radio communication. Thus, even if, *arguendo*, Phillipps teaches the “rejection” limitation of Claim 7, Phillipps fails to teach such “rejecting” in conjunction with the recited “receiving,” as recited by Claim 7. The recited limitations are not found in Phillipps.

With respect to Claim 10, Phillipps fails to teach or fairly suggest the limitation “wherein said Bluetooth communications request is a page message” as recited by Claim 10. Haartsen (US 6,590,928, “Haartsen”) is introduced, but not cited in the rejection, to teach inherency of the recited page message. However, Haartsen is not directed to Bluetooth, and is further incompatible with Bluetooth (Haartsen is directed to a very different and incompatible master/slave communication protocol). Consequently, Haartsen is non-analogous and fails to teach anything related to the recited subject matter. Phillipps is silent as to the limitation “wherein said Bluetooth communications request is a page message” as recited by Claim 10. Haarsen fails to establish that a page message is inherent. The limitations are not taught or fairly suggested by the cited art.

In summary, Applicants respectfully submit that the Examiner’s rejections of the Claims are improper as key limitations needed for proper prima facie rejections of Applicants’ Claims are not met by the cited reference as outlined above. Moreover, because key limitations of independent Claims 1, 7, 13 and 19 (from which Claims 2-6, 8-12, 14-18 and 20-24 depend) are not taught or fairly suggested by Phillipps, Applicants respectfully submit that the rejection of Claims 1-24 under 35 USC 102(e) as being unpatentable over Phillipps is improper and should be reversed.

The Commissioner is hereby authorized to charge any additional fees, which may be required for this request, or credit any overpayment, to Deposit Account 23-0085. In the event that an extension of time is required, or may be required in addition to that


requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account 23-0085.

Respectfully submitted,

WAGNER, MURABITO & HAO LLP

Date:

12/12/2006

  
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